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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,040	12/09/2003	Matthew Bullock	10.065.024	2990
30236	7590	10/18/2005	EXAMINER	
KILE GOEKJIAN REED & MCMANUS 1200 NEW HAMPSHIRE AVE, NW SUITE 570 WASHINGTON, DC 20036			GORDON, STEPHEN T	
			ART UNIT	PAPER NUMBER
			3612	

DATE MAILED: 10/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/730,040	Applicant(s) BULLOCK, MATTHEW	
	Examiner Stephen Gordon	Art Unit 3612	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 4,5 and 7-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 July 2005 and 09 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>7-22-05</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. As previously noted, applicant had previously failed to respond to the election of species requirement included in the response of 1-18-05 to the original office action – note paragraph 5 of the action mailed 12-20-04. Applicant's attorney was contacted via telephone to complete the requirement. Specifically, during a telephone conversation with Bradford Kile on 3-3-05 a provisional election was made with traverse to prosecute the invention of figures 3 and 9, claims 1-3 and 6. Claims 4-5 and 7-23 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention. Applicant should note, claim 1 at first glance would appear to read only on the non-elected embodiment of figure 13 (note reference to spacing of adhesive strips). As previously noted, in as much as the adhesive strips of figure 3 are deemed spaced at least to some degree to correspond to corrugation land areas and in an effort to give applicant the broadest reasonable interpretation of the elected embodiment, claim 1 is deemed to read on the elected embodiment of figure 3. Note also claims 4 and 5 read on the non-elected figure 8 embodiment. Independent claim 7 reads on the non-elected figure 8 embodiment. Claim 11 reads on the non-elected figure 13 embodiment.

2. Additionally note, as discussed with applicant's attorneys in the personal interview of 8-22-05 (note interview summary in the file wrapper), it has been agreed that the examiner would continue to construe the claims as noted above and in the last office action with regard to the election of species. As noted by applicant's attorneys in the personal interview, it is actually the embodiment of figure 13 (as opposed to the

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elected embodiment of figures 3 and 9) which is now desired by applicant for prosecution on the merits. Attorneys for applicant have agreed to file an RCE (request for continuing examination) in response to this action and specifically request that the election be formally changed to the embodiment of figure 13 – note the referenced interview summary. The examiner has agreed that upon such RCE filing, the invention of figure 13 would be taken as the elected embodiment, and an action on the merits directed thereto would be completed. Finally, as noted in the summary of the personal interview, applicant's attorneys have agreed to amend the claims with the RCE filing to include a positive recitation of the container and corrugated sidewalls to better define over the art of record. Moreover, the claims would further define the adhesive strips as corresponding to the "high" land areas of the corrugations – again note the interview summary of 8-22-05.

3. Claims 4-5 and 7-23 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention. Applicant timely traversed the restriction (election) requirement in the reply filed on 1-18-05 and in the telephone conversation of 3-3-05.

4. Figures 4, 5, and 6 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. Additionally, it appears figure 1 should be labeled as --Prior Art--. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing

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figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

5. The disclosure is objected to because of the following informalities: in paragraph 1 – line 5, the period should be a comma. Appropriate correction is required.

6. Claims 1-3 and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Re claim 1, “the lateral spacing” lacks clear antecedent basis – note suggested corrective language relating to this term included in the last office action.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1, 2, 3, and 6, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Bullock '779.

Bullock teaches a load restraining strip applied to corrugated side walls of a transport container including first and second strips/layers of reinforcement material (40,42) as broadly claimed and as best understood. The device further includes a plurality of spaced transverse adhesive strips positioned and with attached release paper strips as broadly claimed– see figure 5 embodiment.

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Re claim 1, the adhesive strips are applied to the land areas as well as the valleys of the corrugations. To the extent that the adhesive strips in the figure 5 embodiment are at least spaced to some degree to correspond to the land areas, they are deemed laterally spaced as broadly claimed. Again applicant should note, in an effort to give applicant the broadest possible interpretation of the elected embodiment of figure 3, this interpretation of Bullock '779 is consistent with such position. Applicant should take care that a position contrary to this may render the elected claims not fairly readable on the elected embodiment of figure 3 and properly withdrawable. In this situation, no pending claims would read on the elected embodiments.

Re claim 2, the release paper strips function as claimed.

Re claim 3, as noted above, strands 40,42 are deemed to comprise first and second reinforcement material as broadly claimed and as best understood.

Moreover, the reference teaches that such materials can be made of bonded strands – such bonding defining a first adhesive layer as broadly claimed and as best understood. The adhesive strips are deemed positioned/applied as broadly claimed and as best understood.

Re claim 6, at least one of the strands relied upon to read on the first strip is high strength and would comprise a monolithic material as broadly claimed.

9. Applicant's arguments filed 7-22-05 have been fully considered but they are not persuasive.

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Regarding applicant's comments regarding the election of species, such issues have been addressed in the agreements reached by applicant's attorneys and the examiner as detailed in paragraph 2 above.

Regarding applicant's comments directed to the art rejection. While such issues may become moot in view of applicant's proposed amendments with the RCE filing noted above, the following should be noted. As currently presented, the instant claims do not positively recite the container and/or wall corrugations. To the extent that such elements are not positively recited and as noted above to the extent that Bullock could function at least to some degree to correspond to wall corrugations, the functional language relating to the container is given little patentable weight. Regarding applicant's remarks directed toward Bullock as applied to claims 2 and 3, while the relied upon elements of Bullock are not identical to applicant's disclosed elements, Bullock is deemed to define the recited elements as discussed *as broadly claimed*.

10. Finally, it is again noted, the examiner has agreed that upon such RCE filing, the invention of figure 13 would be taken as the elected embodiment, and an action on the merits directed thereto would be completed at such time. Additionally, as noted in the summary of the personal interview, applicant's attorneys have agreed to amend the claims with the RCE filing to include a positive recitation of the container and corrugated sidewalls to better define over the art of record. Moreover, the claims would further define the adhesive strips as corresponding to the "high" land areas of the corrugations – again note the interview summary of 8-22-05.


11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Gordon whose telephone number is (571) 272-6661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

 10-13-05
Stephen Gordon
Primary Examiner
Art Unit 3612

stg